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09/820,934	03/30/2001	David W. Cannell	05725.0878-00	4153
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHANNA VAJJALA, LAKSHMI SARADA	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/820,934

Filing Date: March 30, 2001

Appellant(s): CANNELL ET AL.

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Anthony C. Tridico  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10-31-05 appealing from the Office action

mailed 4-18-05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement that there are no related appeals or interferences, interferences, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, is contained in the brief.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-9, 13-19 and 29-31, 33-42 and 56-59.

Claims 29-32 and 43-55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

In response to the terminal disclaimer filed 7-18-05, the double patenting rejections over US 6,486,105 and US application number 09/821,480 has been withdrawn.

Accordingly, the grounds of rejection to be reviewed on appeal is as follows:

Claims 1-9, 13-19, 29-31, 33-42 and 56-59 stand rejected under 35 USC 103(a) as being unpatentable over US 6,495,498 to Niemiec et al (hereafter Niemiec) and US 5688930 to Bertho et al (hereafter Bertho).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 13-19, 29-31, 33-42 and 56-59 stand rejected under 35 USC 103(a) as being unpatentable over US 6,495,498 to Niemiec et al (hereafter Niemiec) and US 5688930 to Bertho et al (hereafter Bertho).

Neimeic teaches detergent and conditioning compositions containing a silicone agent, a conditioning agent, surfactants and detergent, for treating hair, skin or nails, particularly as shampoos. The cationic compounds of Neimeic include cationic cellulose derivatives such as Polymer JR-400 and Polyquaternium-10 (col. 6, lines 2-13), also described in the instant specification as a suitable film-forming agent. Neimeic further teaches adding surfactants, suspending agents; film-forming agents and other hair care actives in the composition. Among the film-forming agents, Neimeic teaches instant claimed polymers such as Polyquaternium-10 as suitable for forming a continuous coat on the hair (col. 13, lines 1-9). Thus, Neimeic teaches Polyquaternium-10 as essential in the composition for conditioning and film-forming effect. Neimeic teaches incorporating surfactants in the composition for cleansing but fails to teach the claimed monosaccharides.

Bertho, discussed above, teaches the claimed alkyl pentosides as surfactants for hair care compositions. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add alkyl pentoside mixture of Bertho in the hair composition containing the Polyquaternium-10 hair conditioner (and film-forming agent) of Neimeic because Bertho suggests that their raw material is cheap having economic advantage (col. 1, lines 35-45) and has the ability to act as a surfactant, enhance foaming, emulsifying and detergent power (col. 6, lines 33-35), which is also desired by Neimeic. Further, the teachings of Neimeic are directed to a hair shampoo and conditioning composition containing detergent surfactants as well as conditioners. Accordingly, one of an ordinary skill in the art would have expected to

improve the emulsifying power of the hair cleansing and conditioning composition of Neimeic with a cheaper material of Bertho.

#### **(10) Response to Argument**

Appellants argue that the office provides no reason, suggestion or motivation in the prior art to lead one of an ordinary skill in the art to combine the teachings of the references because one would have to disregard the most preferred cationic conditioning agents of Neimeic and select a cationic conditioning agent, Polyquaternium-10, from among the other possible classes of cationic conditioning agents. In response to appellant's argument the composition of Neimeic requires cationic conditioning agent as a second essential component. This second component can be chosen from cellulose derivatives, guar derivatives or the cationic compound of formula II (col. 5, lines 20 to col. 6, lines 38), which does not constitute a laundry list of compounds. In particular, Neimeic specifically teaches the claimed Polyquaternium-10 as the suitable and useful cationic cellulose derivative (col. 6, lines 2-7) and not as one out of several possible cationic conditioning agents. Thus, unlike appellants' argument, one of an ordinary skill in the art would not have to go through an extensive list to pick and choose the claimed compound comprising at least two quaternary ammonium groups.

It is argued that the office engages in a multi-step selection process that improperly uses instant invention as a blueprint for hindsight reconstruction of the claimed invention. In response to appellant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellants argue that Neimeic teaches long chain alkyl glucosides as one of several possible nonionic surfactants and as with the selection of Polyquaternium-10, one would have to pick and choose to select the claimed alkyl glucoside from among other preferred nonionic surfactants. It is further argued that in spite of such a selection, the alkyl glucoside of Neimeic is a C6 monosaccharide and is outside the scope of the invention. Appellants argue that the Office's proposed motivation focuses on the substitution of the alkyl pentoside mixture of Bertho for the alkyl glucoside of Neimeic and disregards the fact that there is no motivation to select the alkyl glucoside, that Neimeic lacks more than just a teaching of the alkyl pentoside.

Appellants' arguments are not found persuasive because Neimeic desires the addition of surfactants (anionic, nonionic or cationic), in the hair care composition for cleansing effect and lathering capacity. The teachings of both Bertho and Neimeic are directed to hair care compositions, both desire a cleansing surfactant. Bertho teaches alkyl pentosides as surfactants, which are suitable for use in hair care applications

because of their remarkable non-ionic surfactant property. Further, unlike appellants' arguments, Bertho teaches alkyl pentosides either alone or in combination with other surfactants and not necessarily as a substitution for alkyl glucoside (of Neimeic). The motivation to select the alkyl pentosides of Bertho comes from the fact that Neimeic desires a foaming and cleansing surfactant in the hair care composition containing cationic conditioning agent. The composition of Neimeic also comprises skin active agents to be delivered to hair or skin, and Bertho teaches alkyl pentoside surfactant that has excellent wetting, foaming and emulsifying power and its suitability to skin or hair care detergent owing to its low cost, low irritancy on skin or hair. In particular, Bertho teaches the utility of alkyl pentosides as surfactants in mild shampoos, together with other surfactants (col.17, lines 38 through col. 18). Accordingly, one of an ordinary skill in the art would have been motivated to add the alkyl pentoside of Bertho in the hair care composition of Neimeic with an expectation to achieve the desired foaming and cleansing effect and also a conditioning effect with the hair care composition of Neimeic.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Lakshmi Channavajjala  
Examiner  
Art Unit 1615  
January 19, 2006

Conferees:

  
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